

AMENDMENT UNDER 37 C.F.R. § 1.111
Appln. No. 09/642,201

PATENT APPLICATION

REMARKS

Reconsideration and further examination of this application is hereby requested. Claims 8, 12, and 16 are currently pending in the application. Claims 1-7, 9-12, 13-15, and 17 have been canceled without prejudice to being refiled in a divisional application.

Applicant appreciates the Examiner's indication that claims 8, 12, and 16 recite allowable subject matter.

A. Claim Objections

Applicant thanks the Examiner for the careful critique of the claim wording. The typographical errors noted by the Examiner ("that" being substituted for "than" in each of claim 8, 12, and 16) have been corrected by this Amendment. Accordingly, Applicant respectfully submits that these claim objections have been overcome.

B. Rejection Under the First Paragraph of § 112

Claims 8, 12, and 16 have been rejected under 35 U.S.C. § 112, ¶ 1st as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention at the time the application was filed. This rejection is respectfully traversed based on the following arguments.

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B.1. Written Description

Some language of this rejection sounds in a written description requirement rejection. To the extent that this rejection is styled as being based upon the written description requirement of § 112, ¶ 1st, Applicant respectfully provides the following comments. The correct legal test to apply is whether the disclosure as originally filed puts the public on notice, in such a way as would be recognized by the skilled artisan, that what is now claimed was what Appellant regarded as his invention.

Ralston Purina Co. v. Far-Mar-Co., Inc., 772 F.2d 1570, 1575, 227 U.S.P.Q. 177, 179 (Fed. Cir. 1985). Presence of the claimed subject matter in the originally filed claims is sufficient to demonstrate that the written description requirement has been satisfied. *In re Koller*, 204 U.S.P.Q. 702, 706 (C.C.P.A. 1980) ("[O]riginal claims constitute their own description. Later added claims of similar scope and wording are described thereby."); *Ex parte Porter*, 25 U.S.P.Q.2d 1144, 1146 (Bd. Pat. App. & Int. 1992). Applicant notes that each of claims 8, 12, and 16 is as it was originally filed, with the exception of correcting typographical errors. Accordingly, Applicant respectfully submits that the written description requirement is satisfied as to the subject matter of claims 8, 12, and 16.

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B.2. Enablement

Some language of this rejection sounds in an enablement rejection. To the extent that this rejection is a challenge to the enablement by the specification, Applicant provides the following comments.

The Examiner contends that the specification does not disclose how to determine chip delay of ToSector, nor how do determine chip delay of the earliest arriving multipath sector. The chip delay of each sector is easily knowable because it is preset for every sector in a CDMA-type cellular telephone network. Persons having ordinary skill in the art of cellular telephony would have readily understood this basic aspect of CDMA network operation.

The Examiner contends that the specification does not disclose how to determine the maximum window size. Each sector in a CDMA cellular telephone network has as one of its parameters a maximum window size, which acts as a limit to what the window size may become for that given sector. It is preset for every sector in the network and, thus, is an easily knowable parameter of the network. Persons having ordinary skill in the art of cellular telephony would have readily understood this basic aspect of CDMA network operation.

One aspect of the present invention is that the preset

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parameters of a CDMA network can be improved via an algorithm that analyzes these preset parameters in view of a body of drive test data that has been taken. This algorithm, as it is described in the claims (as a process in claim 8, as part of a computer program product in claim 12, and as operations of a computer-based system in claim 16) selectively modifies the window size of a given sector by either increasing it if such increase is appropriate or making no change to the window size if no increase is appropriate. Part of the algorithm addresses the possibility that by increasing a sector's window size that the maximum window size parameter set for that sector may be exceeded. To avoid any contradiction, if an increased window size would exceed the set maximum window size for that sector, then the maximum window size for that sector is simply increased to be the same as the newly increased window size. This is explained in the specification at page 12, line 21 through page 13, line 2.

Thus, there is no difficulty in determining maximum window size. As explained above, the preset maximum window size is a preset value that is knowable for each sector in a CDMA network, and potential modifications of those parameters for the sectors is determined according to the present invention based on the text that bridges pages 12 and 13 of the specification.

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The Examiner expresses concern that the term "maximum window size" is not defined in such a way as to be clear and concise. The term "window size" is a well known term of art within the field of CDMA cellular telephony. By way of example, the distribution to the sectors and the mobile units of window size parameters from a central system controller is described in a prior publication in this art, patent US 5640414. A maximum window size is pretty self explanatory - a value that the window size is not to exceed. This, too, is a well known term of art within the field of CDMA cellular telephony. Although not articulated by the Examiner, it may be that the Examiner is unclear as to whether the "maximum window size" is a global maximum for the entire network, or merely for each individual sector in the network. It is the latter, as is clear from the description in the text that bridges pages 12 and 13 of the specification.

Since all the terms called into question by the Examiner would have been understood by persons having ordinary skill in the art, Applicant respectfully submits that the claimed invention is sufficiently enabled so as to be practiced by persons having ordinary skill in the art without resort to undue experimentation.

In view of the above comments, Applicant respectfully

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requests that the rejection under the first paragraph of § 112 be carefully reconsidered and withdrawn.

C. Rejection Under the Second Paragraph of § 112

Claims 8, 12, and 16 have been rejected under 35 U.S.C. § 112, ¶ 2d as being indefinite. In particular, the Examiner expresses concern that iterative practice of an algorithm according to the present invention would lead to confusion as to what the term "maximum FromSector window size" might represent in an iterative context. This rejection is respectfully traversed based on the following arguments.

First, a few words about the scope of these claims: Although the invention as disclosed in the specification encompasses a process that uses an iterative algorithm, Applicant has intentionally chosen not to claim the iterative aspect of the invention. Each of the elected claims 8, 12, and 16 is intentionally drafted so as to be sufficiently broad that infringement of the claim would occur if only a single instance of the claimed steps were to be practiced. Repetition of those steps is intentionally not claimed so as to provide the broadest reasonable protection for the invention.

Thus, to criticize the claims as being unclear in an iterative context is not relevant since iteration is not claimed.

Persons having ordinary skill in the art do not need to

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understand the scope of this claim in an iterative context since only a single-instance practicing of the claimed steps would constitute an infringement. Repeated practicing of the claimed steps would simply be repeated infringement.

To improve the clarity of the claims, Applicant has amended "maximum window size" to read as "maximum FromSector window size" so as to provide verbatim literal antecedent basis for the later instance of that term in each claim.

In view of the above, Applicant respectfully requests that the rejection under the second paragraph of § 112 be carefully reconsidered and withdrawn.

C. Closing

For the above reasons, Applicant respectfully submits that the application is in condition for allowance with claims 8, 12, and 16. If there remain any issues that may be disposed of via a telephonic interview, the Examiner is kindly invited to contact the undersigned at the telephone number given below.

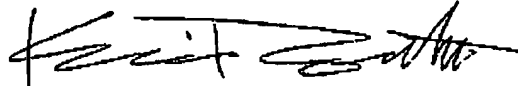
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The Director of the U.S. Patent & Trademark Office is authorized to charge any necessary fees, and conversely, deposit any credit balance, to Deposit Account No. 18-1579.

Respectfully submitted,

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